

REMARKS

Status of the Claims

Claim 1 is presently amended. Claims 4 and 8-9 were previously canceled.

Applicants have amended claim 1 to read "... wherein the hybridization reagents comprise SEQ ID NOS: 3, 4, 5, 8, 9, 12 and 13". Support for these amendments can be found in the Examples provided in the specification as filed, for example on page 28. No new matter is added by this amendment.

With entry of this amendment, claims 1-3 and 5-7 are currently pending and under consideration.

Double Patenting

The Examiner has provisionally rejected claim 1 on the grounds of nonstatutory obviousness-type double patenting over claims 1, 2 and 6 of copending Application No. 10/534,955 in view of Jannes et al. Additionally, the Examiner has provisionally rejected claim 1 on the grounds of nonstatutory obviousness-type double patenting over claim 1 of copending Application No. 10/532,319.

If a "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw the rejections and permit the application to issue as a patent. Application Nos. 10/534,955 and 10/532,319 are not currently allowed. Accordingly, Applicants submit if these provisional rejections are the only outstanding rejections, the present claims should be allowed. However, Applicants will consider filing Terminal Disclaimers when the present claims are indicated as otherwise allowable if/when Application Nos. 10/534,955 and 10/532,319 are allowed.

Claim Rejections – 35 USC §103

The Examiner has rejected claims 1-3 and 7 under 35 USC 103(a) as being unpatentable over Edward et al in view of Forsman and Bergeron. (Action page 6). The Examiner asserts, in part, that it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the teaching of Edwards to target the 16S rRNA spacer sequence as taught by Forsman to arrive at the claimed invention with a reasonable expectation for success. Further the Examiner asserts that one of ordinary skill in the art at the time the invention was made would have

been motivated to have extended the methods taught by Edwards and Forsman to incorporate the internal control template as taught by Bergeron. (Action page 10)

Solely to facilitate prosecution and without acquiescence in the rejections, Applicants have amended claim 1 to include specific sequence identifier limitations: "wherein the hybridization reagents comprise SEQ ID NOS: 3, 4, 5, 8, 9, 12 and 13". Applicants assert that none of the cited references teach the method provided in the present invention for use of this specific combination comprising seven defined hybridization reagents for identification of a pathogenic organism from a predetermined group of pathogens. None of the cited references, individually or in combination, provide the limitation wherein the hybridization reagents comprise SEQ ID NOS: 3, 4, 5, 8, 9, 12 and 13.

With entry of the present amendments, Applicants respectfully submit that the Examiner has not provided a *prima facie* case of obviousness because the combination of Edwards, Forsman and Bergeron does not anticipate each every limitation set forth in the claims.

For the reasons provided above Applicants respectfully request reconsideration and withdrawal of the §103 rejections.

The Examiner has rejected claim 5 under 35 USC 103(a) as being unpatentable over Edwards in view of Forsman and Bergeron as applied above, further in view of Jannes. (Action page 11). The Examiner asserts, in part, that it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the teachings of Edwards, Forsman and Bergeron in the include the targets of gram positive and gram negative bacteria as taught by Jannes to arrive at the claimed invention with a reasonable expectation for success. (Action page 12)

As discussed above, the Examiner has not established that the Edwards, Forsman and Bergeron references teach all of the elements of claim 1 or its dependents, which include claim 5. The teachings of Jannes do not correct these deficiencies. Thus, the Examiner has not established a *prima facie* case of obviousness based on the teachings of Edwards, Forsman and Bergeron and Jannes, and therefore Applicants respectfully request the reconsideration and withdrawal of the §103 rejections of claim 5.

The Examiner has rejected claim 6 under 35 USC 103(a) as being unpatentable over Edwards in view of Forsman and Bergeron as applied above, further in view of Loeffler. (Action page 12). The Examiner asserts, in part, that it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the teachings of Edwards, Forsman and Bergeron

to detect additional species, including yeast, as taught by Loeffler to arrive at the claimed invention with a reasonable expectation for success. (Action page 13)

As discussed above, the Examiner has not established that the Edwards, Forsman and Bergeron references teach all of the elements of claim 1 or its dependents, which include claim 6. The teachings of Loeffler do not correct these deficiencies. Thus, the Examiner has not established a *prima facie* case of obviousness based on the teachings of Edwards, Forsman and Bergeron and Loeffler, and therefore Applicants respectfully request the reconsideration and withdrawal of the §103 rejections of claim 6.

CONCLUSION

Applicants respectfully request entry of the present amendments and remarks. In view of the above, Applicants believe all claims now pending in this Application are in condition for allowance. If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-730-8566.

Applicants respectfully request a 2-month extension of time to respond to the Office Action mailed April 14, 2009. The response date was July 14, 2009; with the granting of this request, the response time is re-set to September 14, 2009.

The commissioner is hereby authorized to charge the amount of \$ 490, the fee due under 37 CFR §1.17(a)(2) to Deposit Account No. 50-0812. Please grant any additional extensions of time that may be required to enter this amendment and charge any additional fees or credit any overpayments to Deposit Account No. 50-0812.

Please direct all future correspondences to: Customer No. 22829.

Respectfully submitted,

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